

REMARKS

I. Prosecution History

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. Under the first non-final Office Action, dated October 4, 2007, claims 1-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Murren et al. (US Pub No 2003/0110085). Applicant amended claims 1, 6, 12 and 13 and requested reconsideration of the application.

Claims 1-13 were then finally rejected in a final Office Action, dated April 29, 2008, under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (2002/0007374). Applicant cancelled claims 7 and 8 and amended claims 6, 9, 10, 11 and 12 to place the application in condition for allowance.

Under the current Advisory Action, claims 1-13 stand rejected. The amendments to claims 6 and 12 were not entered. The Examiner maintains the rejection to claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks.

Applicant now files a Request for Continued Examination and provides this paper as his submission under 37 CFR 1.114. Applicant herein submits a request for reconsideration of his application given the following amendments and arguments.

II. Claim Rejections – 35 U.S.C. §103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (KSR Int'l v. Teleflex Inc.) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a reason that would have prompted a person to combine the elements and to make that analysis explicit. MPEP §2143 sets out the further basic criteria to establish a prima facie case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a prima facie showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection) and of a prima facie showing by the examiner of a reason to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Murren in view of Marks

Claims 1-13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (US Pub No. 2002/0007374).

Regarding claims 1, 6 and 12, the Examiner argues that the claim limitations that were added did not coincide with the limitations of claim 1 which would require a new search of the subject matter. The Applicant respectfully disagrees with this assessment and submits that the current amendments to claims 1, 6 and 12 render the Examiner's arguments moot.

Regarding claims 1-13, the Examiner has maintained that the claimed invention would have been obvious to one with ordinary skill in the art at the time

of the invention in light of the disclosures of Murren in view of Marks. The Applicant respectfully disagrees with this assessment and submits that claims 1, 6 and 12 have been amended to include the limitation of "print-ready" documents in order to further clarify the structural distinctions of the claimed invention. The advantage of being able to transmit print-ready documents is that they can be sent directly to a printer, eliminating the need to repeat the conversion or decomposition process if another copy of the document is desired. This also allows for documents created in one location to be automatically routed to a print service and printer hundreds or even thousands of miles away, in seconds or minutes.

While Marks does suggest that an input/output device may include one or more printers (paragraph 30), neither Marks nor Murren disclose transmitting print-ready or print-formatted documents using a multicast communication transport layer. Minimizing the number of conversions/decompositions is indicative of the increased efficiency provided by the Applicant's invention. Based on the foregoing, the Applicant respectfully asserts that one having ordinary skill in the art at the time of invention would not have been successful in combining the disclosures of Murren and Marks to achieve all of the limitations of Applicant's invention. Therefore, the Applicant respectfully requests a withdrawal of the finality of the Office Action and reconsideration of claims 1-13 as amended herein.

III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention and now respectfully request the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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